

Attorney Docket # 5106-5

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Alex MASHINSKY et al.

Serial No.: 10/014,103

Filed: December 11, 2001

For: Method And System For Facilitating Trading of  
Media Space

Examiner: Borlinghaus, Jason  
Group Art: 3693

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This is a Request for a Panel Review of Issues on Appeal in accordance with the Office Gazette Notice dated July 12, 2005. The present request is filed concurrently with a Notice of Appeal and is filed before an Appeal Brief. No amendments are being filed with this request.

This Notice of Appeal and Request is filed in response to the final Office Action dated February 9, 2007.

Arguments supporting the Request for Review begin on page 2 of the present communication.

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## ARGUMENTS

The matters to be reviewed are whether independent claims 1, 9, and 12 are unpatentable over U.S. Patent No. 6,324,519 (Eldering) in view of U.S. Patent No. 4,903,201 (Wagner).

Independent claim 1 recites “a server node operatively connectable to user interfaces for receiving a request for media space from a buyer and an offer of media space from a seller, said server node comprising a set of rules including a deal execution requirement for matching the request and the offer, for executing a trade between the matched buyer and seller in accordance with a deal execution requirement”.

Independent claim 9 recites “receiving, at a server node, a request for media space from a buyer and an offer of media space from a seller”, “matching, at the server, the request of the buyer and the offer of the seller”, and “executing, at the server node, a trade between the matched buyer and seller according to predetermined rules including a deal execution requirement”.

Independent claim 12 recites “receiving, at a server node, a request for media space from a buyer and an offer of media space from a seller, matching a request of one of the buyers and an offer of one of the sellers at the server node that satisfy a deal execution requirement to form a matched pair, executing, at the server node, a trade between the buyer and the seller, and facilitating delivery of the media content between the matched buyer and seller”.

The Examiner acknowledges that Eldering fails to disclose “a set of rules including a deal execution requirement for matching the request and the offer, for executing a trade between the matched buyer and seller in accordance with a deal execution requirement”, as recited in the independent claims. However, the Examiner contends that such activities are old and well known in the art and cites Wagner as an example.

As stated in MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits the Examiner's rejection of the present application fails to meet at least the first and third of the above criteria and thus fails to establish a *prima facie* case of obviousness at least for the following reasons: (1) there is no suggestion or motivation, express or implicit, in the references or in the knowledge available to one of ordinary skill in the art to combine the teachings of Wagner to the system of Eldering and (2) the combined teachings of Eldering and Wagner fail to disclose, teach or suggest the claimed invention.

#### No Suggestion to Combine Absent Impermissible Hindsight Reconstruction

Applicant submits that there is no motivation to combine features of the advertising auction of Eldering with the commodities trading exchange of Wagner.

An objective of Eldering is to provide more targeted advertising so that advertisers may target ads at consumers with appropriate demographic characteristics and consumers receive more targeted advertisements which match their lifestyles and interests (see col. 2, lines 5-20). Accordingly, Eldering discloses an advertisement auction system wherein a content/opportunity provider 160 (i.e. a seller) may auction to one or more advertisers 144 (i.e. buyers) certain advertising space/opportunities. In particular, a content/opportunity provider 160 transmits an announce opportunity message to one or more advertisers 144 (see col. 9, lines 50-52 of Eldering). Advertiser 144 then transmits an ad characterization to either the content/opportunity provider 160 or profiler 140 (col. 10, lines 1-3). Profiler 140 maintains a consumer profile server 130 which contains a characterization of the consumer 100 (col. 4, line 11 - Col. 5, line 38). A correlation factor determines the appropriateness of the ad for particular consumers, which is used by the advertiser 144 to determine whether to place a bid and the provider 160 determines whether to accept the bid (see col. 1, lines 50-55).

Wagner discloses an automated futures trading exchange for automatically transacting sales of future commodity contracts (see, e.g., col. 5, lines 5-15 of Wagner). As defined by the Merriam-Webster Collegiate Dictionary, Tenth Edition, 1996, commodities are economic goods or articles of commerce, such as a mass-produced unspecialized product, and commodity futures relates to entering a contract now to sell or buy a specific amount of such goods at a later date at a price determined at the time of the contract. Typically, there is no difference between individual units of a commodity except price. In contrast, in the present invention, each media

space offered by a content/opportunity provider possesses unique characteristics based, at least in part, on the demographics of the consumers viewing that space. Therefore, the contracts made by Wagner's trading exchange for trading commodity futures have no relevance to Eldering's system for auctioning unique media space (which is typically characterized by the specific demographics of the consumer users of the media space obtained by the consumer profiler) to provide targeted advertising. Accordingly, there is no motivation or suggestion for combining any of the teachings of Wagner with the system of Eldering by a person of ordinary skill in the art of advertising or in the art of commodities trading in the manner taught by the present invention. Moreover, an auction system is materially different from a trading system as was pointed out in the recent Examiner's interview on November 8, 2006, the results of which was memorialized by the Examiner in the Interview Summary mailed on December 1, 2006. Without the requisite guidance by the prior art references, it is respectfully submitted that the Examiner's rejection rests solely on an "obvious to try" approach that is impermissible hindsight reconstruction.

The Combined Teachings of Eldering and Wagner Do Not Disclose or Teach the Present Invention

The consumer profile 140 of Eldering does not disclose or teach a server node that receives a request for media space from a buyer and an offer of media space from a seller and matches the request with the offer and executes a trade in accordance with a deal execution requirement as required by independent claims 1, 9 and 12. In contrast, Eldering discloses that a content/opportunity provider 160 transmits an announce opportunity message to one or more advertisers 144, as described above. The consumer profiler 140 merely provides information regarding consumer profiles to the buyer or seller and has nothing to do with the matching of the offer by the provider and bid by the buyer for trade execution as required by the claimed invention. More specifically, the consumer profiler 140 of Eldering, as its name suggests, collects consumer profiles and provides consumer profiles to the buyer or seller (see col. 4, line 11 to col. 5, line 38; and col. 10, lines 21-23 of Eldering). As stated above, it is the owner of the advertising space in Eldering, i.e., the seller, that decides whether to accept a bid. The presently claimed invention, however, recites "a server node operatively connectable to user interfaces for receiving a request for media space from a buyer and an offer of media space from a seller, said server node comprising a set of rules including a deal execution requirement for matching the request and the

offer, for executing a trade between the matched buyer and seller in accordance with a deal execution requirement”.

Applicant submits that Eldering and Wagner references are not combinable absent the teaching of the present application. Wagner teaches that a transaction for matched bid and offer for a commodity can be automatically completed by a computerized trading system and Eldering teaches that a media space may be profiled and auctioned by a seller of the media space. Such teachings, however, do not motivate one of ordinary skill in the art to create the presently claimed invention. As specified in the MPEP and as further noted by the Federal Circuit, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Because of the above-described differences between commodities and advertising space, the combined disclosures of Eldering and Wagner fail to teach or suggest “matching, at the server, the request of the buyer and the offer of the seller”, and “executing, at the server node, a trade between the matched buyer and seller according to predetermined rules including a deal execution requirement”, wherein the request is a request for media space from a buyer and the offer is an offer of media space from a seller, as expressly recited in independent claims 1, 9, and 12.

#### Examiner’s Response to Arguments in the final Office Action

In the final Office Action, the Examiner disagrees with Applicant’s assertion that Eldering fails to teach a server node with the same functionality as the instant application and cites consumer profile 140 of Eldering as disclosing the claimed server node. As described above, the consumer profile 140 is solely a repository for consumer related data and thus fails to disclose, teach or suggest the claimed server node.

The Examiner further states that Eldering does not teach a model “wherein a single seller auctions its advertising space to a plurality of buyers”. Applicant notes that although there may be more than one provider in Eldering, each content/opportunity provider 160 transmits an announce opportunity message to one or more advertisers 144 (see col. 9, lines 50-52 of Eldering). Moreover, there is no server node in Eldering that receives both opportunity messages from multiple providers and bids from buyers.

The Examiner further states that Eldering does not operate in a manner "without requiring a server node to act as an intermediary" as we previously argued. Applicant notes that the claim language requires the server node to act as an intermediary between a buyer and a seller, i.e. to execute a trade between the matched buyer and seller according to predetermined rules including a deal execution requirement. As stated above, there is no intermediary server in Eldering that receives both opportunity messages from multiple providers and bids from buyers for the purpose of trading media space as claimed.


**Conclusion**

For all of the above reasons, the Examiner has not made a *prima facie* case for obviousness of independent claims 1, 9, and 12 and the rejection of claims 1-34 should be withdrawn.

Applicant notes the Examiner's objection to claim 3 and agrees with the Examiner's suggested amendment.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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